

## **REMARKS**

In view of the following remarks, reconsideration of this application is respectfully requested.

### **Status of the Claims**

Claims 1-20 are currently pending. Claims 15-20 are under examination. Claims 1-14 stand withdrawn as being directed to non-elected subject matter.

### **Rejoinder of the Claims**

On October 16, 2008, applicants amended independent claim 15 (directed to a composition) by inserting therein the process steps of currently withdrawn independent claim 1. Currently withdrawn claims 2-14 depend either directly or indirectly from claim 1. In view of the aforementioned amendment to claim 15, applicants respectfully request that withdrawn claims 1-14 be rejoined in the present application.

If the Examiner continues to maintain claims 1-14 as being withdrawn, applicants continue to reserve the right to pursue the subject matter of the non-elected claims in this or a later-filed continuing or divisional application. Applicants also reserve their right to rejoinder of the withdrawn process claims pursuant to MPEP § 821.04 upon notification of an allowable product claim.

In view of applicants' provisional election of "cappaprenol 12" and "palmitic acid" as the species of cappaprenol and fatty acid, respectively, applicants reiterate that, upon allowance of a generic claim, applicants are entitled to claim additional non-elected species that fully embrace the allowed generic claim.

**Rejection Under 35 U.S.C. § 102(a)**

Claims 15 and 17-20 are rejected under 35 U.S.C. § 102(a) for allegedly being anticipated by Schutz et al., “Caper Bud Extract: A New Tool Against Cutaneous Hypersensitivity,” *SOFW* 130 (9):57-64 (2004) (the “Schutz Article”).

In view of the following remarks, applicants respectfully traverse this rejection and request that it be withdrawn.

The Schutz Article describes applicants’ own work. Further, the Schutz Article was published in September 2004, which is after the April 16, 2004 priority date of the present application. Therefore, the Schutz Article does not qualify as prior art against the claims of the present application. *See* MPEP § 2132.01.

In support of applicants’ position, applicants submit herewith declarations by the two co-authors of the Schutz Article and by each of the five inventors of the present application, as follows:

- (i) Declaration of Caroline Schutz Under 37 C.F.R. § 1.132 (the “Schutz Declaration”);
- (ii) Declaration of Jérôme Grousseau Under 37 C.F.R. § 1.132 (the Grousseau Declaration”)
- (iii) Declaration of Estelle Bonnet Under 37 C.F.R. § 1.132 (the “Bonnet Declaration”);
- (iv) Declaration of Alain Guichon Under 37 C.F.R. § 1.132 (the “Guichon Declaration”);
- (v) Declaration of Virginie Charton Under 37 C.F.R. § 1.132 (the “Charton Declaration”);
- (vi) Declaration of Vincent Hubiche Under 37 C.F.R. § 1.132 (the “Hubiche Declaration”); and
- (vii) Declaration of Paula Lennon Under 37 C.F.R. § 1.132 (the “Lennon Declaration”).

The Schutz and Grousseau Declarations are collectively referred to herein as the “Co-Author Declarations.” The Bonnet, Guichon, Charton, Hubiche, and Lennon Declarations are collectively referred to herein as the “Inventor Declarations.”

***The Schutz Article Describes Applicants’ Own Work***

Gattefossé SAS (Saint-Priest, France) is the assignee of the present application. The Schutz Article was co-authored by Caroline Schutz and Jérôme Grousseau, Ph.D., both of whom were employees of Gattefossé SAS at the time of the article (Co-Author Declarations, at ¶¶2-3). Ms. Schutz and Dr. Grousseau are also currently employed by Gattefossé SAS (*Id.* at ¶1).

As set forth in their respective declarations, Ms. Schutz and Dr. Grousseau are each familiar with the subject matter described and currently claimed in the present application (Co-Author Declarations, at ¶4). They are also aware that the Schutz Article has been asserted in the currently pending Office Action as prior art against the claims of the present application (*Id.*). Further, they each have reviewed the prior art rejections based on the Schutz Article, as set forth on pages 3-6 of the aforementioned Office Action (*Id.*).

Both Ms. Schutz and Dr. Grousseau confirm that the data, procedures, and other information disclosed in the Schutz Article, and attributed to the Schutz Article on pages 3-6 of the Office Action, were derived from the work done by the inventors of the present application, and correspond to the subject matter described and/or claimed in the present application (Co-Author Declarations, at ¶7).

Similarly, the five inventors of the present invention are each familiar with the Schutz Article (Inventor Declarations, at ¶3). The five inventors are also each aware that the two co-authors of the Schutz Article were employees of Gattefossé SAS at the time of the drafting and publication of the Schutz Article. (*Id.* at ¶4). Further, each of the five inventors are aware that the Schutz Article has been asserted in the currently pending Office Action as prior art against the claims of the present application (*Id.* at ¶5).

Each of the five inventors has reviewed the prior art rejections based on the Schutz Article, as set forth on pages 3-6 of the aforementioned Office Action (Inventor Declarations, at ¶5). As such, each of the five inventors confirm that the data, procedures, and other information disclosed in the Schutz Article, and attributed to the Schutz Article on pages 3-

6 of the Office Action, were derived from the work done by the inventors, and correspond to the subject matter described and/or claimed in the present application (*Id.* at ¶ 8).

Thus, in view of the foregoing, it is clear that the Schutz Article does not qualify as prior art against the present invention, because the Schutz Article describes applicants' own work.

***The Schutz Article Was Published After the Priority Filing Date***

The present application claims priority benefit of French Application No. 04.04152 (the "French Application"), filed **April 16, 2004**. An official certified copy of the French Application was submitted to the U.S. Patent and Trademark Office ("USPTO") on October 13, 2006. The French Application was written in the French language. However, an ***English language translation*** of the French Application was also submitted to the USPTO on October 13, 2006. Applicants further assert that the content of the English language translation is the same as the original French Application, and therefore contains no new matter in relation to the French Application. Therefore, April 16, 2004 is the correct effective filing date for the present application.

As set forth in both of the Co-Author Declarations (at ¶6) and in all five of the Inventor Declarations (at ¶7), the Schutz Article was published in **September 2004**, which is clearly after the April 16, 2004 effective filing date of the present application. Thus, the Schutz Article does not qualify as prior art against the present application.

Further, applicants note that the International Search Report issued in the corresponding PCT application (PCT/FR2005/050180) designated the Schutz Article as a "T" document. It is well known that, under PCT practice, a "T" document is defined as a "later document published **after** the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention" (International Search Report, at page 1, below Box C) (emphasis added). This is further evidence of the unavailability of the Schutz Article as prior art against the present invention.

For the foregoing reasons, applicants respectfully submit that the rejection of claims 15 and 17-20 under 35 U.S.C. § 102(a) for allegedly being anticipated by the Schutz Article is improper and should be withdrawn.

**Rejection Under 35 U.S.C. § 103**

Claims 15-20 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the Schutz Article.

Applicants respectfully traverse this rejection for the same reasons as set forth above with regard to the anticipation rejection based on the Schutz Article. In particular, the Schutz Article does not qualify as prior art against the present application.

Thus, applicants assert that this rejection based on obviousness grounds in view of the Schutz Article is improper and should be withdrawn.

## CONCLUSION

Claims 1-20 are currently pending in this case, with claims 1-14 being withdrawn and claims 15-20 now under consideration. In view of the foregoing, applicants respectfully submit that the claims of the present application are in condition for allowance and such allowance is earnestly solicited.

If any unresolved issues remain that might prevent the prompt allowance of the present application, the Examiner is respectfully encouraged to contact the undersigned at the telephone number listed below to discuss these issues.

A one-month extension of time fee is being submitted herewith via EFS-Web. However, the Commissioner is hereby authorized to charge any fees that may have been overlooked, or to credit any overpayments of fees, to Deposit Account No. 08-1935.

Respectfully submitted,

HESLIN ROTHENBERG FARLEY & MESITI P.C.

By: **/Andrew K. Gonsalves/**

Dated: **May 23, 2009**

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